

R e m a r k s

After careful consideration of the outstanding Office Action, this application is resubmitted for favorable consideration of the claims on the merits absent amendment.

Independent apparatus claim 1 and independent method claim 7 stand "rejected under 35 U.S.C. 103(a) as being unpatentable over Halasz et al. (5,222,385) in view of Wlodek (3,017,697)." The singular issue involved is whether the Examiner appropriately applied the test of obviousness, i.e., "whether the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The Graham court stated:

[8] While the ultimate question of patent validity is one of law, A. & P. Tea Co. v. Supermarket Corp., *supra*, at 155, 87 USPQ at 307, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Twenty years later in Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597, the Court of Appeals, Federal Circuit, adhered to and

re-emphasized the three Graham conditions by using the word "whole" four times as follows:

A § 103 determination involves fact and law. There may be these facts:

What a prior art patent **as a whole** discloses; what it in fact discloses to workers in the art; what differences exist between the entire prior art, or a **whole** prior art structure, and the **whole** claimed invention; what the differences enabled the claimed subject matter as a **whole** to achieve; that others for years sought and failed to arrive at the claimed invention; that one of those others copied it; that the invention meant on its merits with outstanding commercial success. (The Graham court specifically admonished against interpreting any prior art by selecting therefrom "bits and pieces" as opposed to considering the entire prior patent "as a whole.")

The latter admonishment against so-called "hindsight" has been followed by the courts and the Patent Office for many years, notable among many decisions being In re Gurley, 31 USPQ2d 1130 in which the U.S. Court of Appeals, Federal Circuit, stated "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following a path set out in the reference or would be lead in a direction divergent from the path that was taken by the Applicant."

With the foregoing decisions in mind, it is believed that the "differences between the prior art and the claims at issue" are fairly clear, namely, the last clause of claim 1 reciting "in which the or each reform roller has a textured surface," and a similar last limitation of method claim 7 reciting "controlling the depth of the dome by using reform rollers which have a textured surface." Though the last limitation of each of claims 1 and 7 has been emphasized, it is pointed out that "the whole claimed invention" must be considered (Panduit, *supra*).

The second fact requiring resolution is "what a prior art patent as a whole discloses" (Panduit, *supra*), and more specifically precisely that which is disclosed by the secondarily applied Wlodek patent (3,017,697) when considered in its entirety or "as a whole."

The Examiner selected a very narrow approach with respect to interpreting that which the Wlodek patent allegedly teaches. Reference is first made to column 1, lines 20 through 25 which describes strengthening and improving metal by such conventional treatments as shot peening, regular cold rolling, carburizing or nitriding of steel, etc. The Examiner next moves to column 3, lines 30 through 35 which states:

In the case of tubular metal members, pressure vessels, cylinders and other hollow members, the grooves or depressions may be impressed on the outer or inner surface or both; these impressed grooves and crests, the surface of which may be either machined or not, may serve also as guides for other moving elements or serve as a 'grip' for paint, plastic and other surface protective material.

The next reference is made to column 4, lines 28 through 31 which simply states:

To strengthen a bar, pipe or other element against reverse bending stresses, considerable locked-in compression stresses parallel to the longitudinally axis of the rod or element should be built up.

Based upon the foregoing three disclosures in the Wlodek patent, the Examiner concluded "that it is known to provide roller surfaces with various texturing surfaces that contact a tubular metal body in order to strengthen the metal." The latter is an interesting conclusion but fails to take into consideration the scope and content of the Wlodek teaching when considered in its entirety or "as a whole."

First and foremost, the Examiner finds alleged “texturing surfaces” on/in the roller surfaces of Wlodek, though the patent itself makes no mention of the word “texture,” the phrase “texturing surfaces,” or any words or descriptions equivalent thereto. Preferred first and second definitions of “texture” when used in the common sense thereof appear in Merriam Webster’s Collegiate Dictionary (Tenth Edition) as follows:

1 a : something composed of closely interwoven elements; *specif:* a woven cloth **b :** the structure formed by threads of a fabric

In contrast to the latter, the Wlodek patent teaches impressing “hollows, grooves or depressions” in metal structure members, such as a metal member 1 in Figure 1 having valleys or grooves 2 and crests or untreated portions 3. Whether applied to a round metal bar (4 of Figure 2) or a plate or to “the interior surfaces of hollow members, e.g., cylinders, hollow-shafts, marine-shafts, tubes, gun barrels, drill pipes, and the like” (column 7, lines 36-40), the spaces between the grooves, the widths of the grooves and the width of the untreated portions, as reflected in the first tabulation at the top of column 5, reflect the clear absence of any texturing whatsoever. Therefore, there is no basis for the Examiner’s interpretation of the Wlodek teaching as providing “texturing surfaces” to roller surfaces.

The next interesting part of the Examiner’s broad interpretation of the Wlodek teaching is that such alleged texturing surfaces of the rollers “contact a tubular metal body in order to strengthen the metal.” However, it is clear from the totality of the specification of Wlodek, particularly column 7, lines 30-40 and the paragraph bridging columns 8 and 9 that the tubes are grooved only interiorly thereof, such as providing “the rifling of a gun barrel” (column 3, line 44) or a thimble 66 (Figures 18 and 22). A careful reading

of this patent should convince the Examiner that the rollers form hollows, grooves, or depressions externally of bar stock, internally of tubular metal bodies and internally of metal tubs. Therefore, if one truly followed the teachings of Wlodek "as a whole," one might be lead to provide grooves, depressions or hollows internally of the container 20 (Figure 8) along the inner surface of the side wall 24. Wlodek at least suggests with respect to Figures 18 and 22 that for certain type of tubs or cups the interior thereof could be provided with hollows, depressions or grooves, but in reality there is no suggestion to a person skilled in the art that this teaching would be transferable or utilized in the container art.

It is apparent from the record that Applicant's disclosure was used through hindsight in the Examiner's selection, broad interpretation and broad application against independent claims 1 and 7. A person skilled in the art having the Wlodek teaching before him and being concerned with manufacturing a can body would certainly not be lead to utilize a reform roller having a textured surface.

Even if one were to admit that the grooves 31, for example, of the roller 32 of the Wlodek patent were either interpreted as or were equivalent to a "textured" surface, the question presented is – Where is there a teaching in either Wlodek or Halasz et al. of utilizing the same to reform a "can base" (claim 1) or, more specifically, the "inner wall of the can base" (claim 7)? The Wlodek teaching, as heretofore noted, utilizes grooves 31 of a roller 32 (Figures 12b-12h, for example) to form grooves, hollows, depressions and/or ridges in the exterior surface of a flat metal plate (Figures 1 through 11), bar stock (Figure 12), axles (63 of Figure 12i), and in interior surfaces of tubes 30 (Figure 13a-13d) and thimbles or cups 66

(Figures 18 and 22). Nowhere, and the undersigned stresses the word "nowhere," is there any teaching in either patent when considered as a whole which renders obvious the totality of apparatus claim 1 and method claim 7, particularly the application of textured rollers against a can base and, with respect to claim 7, specifically with respect to an inner wall of the can base.

In view of the foregoing, the patent to Wlodek fails as a valid secondary teaching when considered in its entirety or "as a whole," and based thereupon the 35 U.S.C. § 103 rejection is considered invalid and untenable, and the withdrawal thereof is respectfully requested.

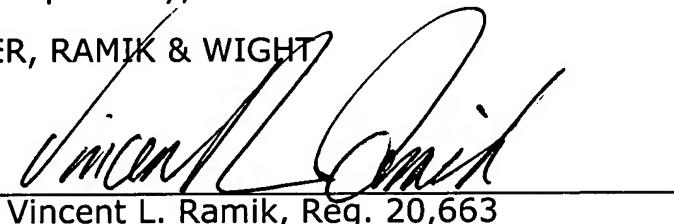
Inasmuch as independent claims 1 and 7 are directed to unobvious subject matter, upon the formal allowance of each independent claim, the allowance of the claims depending therefrom will naturally follow.

In view of the foregoing, the formal allowance of this application at an early date is herewith respectfully requested.

Very respectfully,

DILLER, RAMIK & WIGHT

By:



Vincent L. Ramik, Reg. 20,663

Merrion Square Suite 101
7345 McWhorter Place
Annandale, Virginia 22003

(703) 642-5705 - telephone
(703) 642-2117 - fax